

## REMARKS

This communication is responsive to the Final Office Action dated December 19, 2001. By this response, Applicant has cancelled claims 10-19 without prejudice or disclaimer, and has added new claims 21-39. Claims 1-9 and 21-39 (5 independent and 22 dependent claims) are pending after entry of this Amendment. Support for the amendments is found in the specification, drawing figures and claims originally filed. No new matter is added by this Amendment. **The Office is authorized to deduct any fees that may be due (including any fees for extensions of time or additional claims) from Deposit Account No. 19-2814.**

### **Prior Art Rejections**

The Final Office Action rejects previously-pending claims 1-8, 10, and 17-20 under 35 U.S.C. sec. 103, citing U.S. Patent No. 4,120,031 ("Kincheloe") in view of U.S. Patent No. 6,161,100 ("Saar"). The Office Action rejects prior claims 9 and 11-16, citing Kincheloa in view of Saar and in further view of U.S. Patent No. 5,943,656 ("Crooks"). The Final Office Action essentially repeats the rejections set forth in the first Office Action dated June 20, 2001, stating that Applicant's remarks in the response filed on September 24, 2001 were non-persuasive.

Applicant filed a Continued Prosecution Application claiming priority of the earlier-filed application on March 19, 2001. Applicant respectfully traverses the rejections set forth in the Final Office Action in that (i) there is no motivation to combine the references as suggested in the office action, and (ii) even the combination of the cited reference would not disclose each and every element of the present claims.

As described by the amended claims, the various embodiments of the present invention include systems and methods for providing utility consumption information to consumers so that they may better manage their utility costs. The data processing system suitably receives metering information from a meter at a remote location and computes a utility cost based upon the metering information and upon cost factors associated with a utility source. This cost information may then be provided to the utility consumer, who uses the data to manage utility costs by, for example, shifting production times, purchasing energy from an alternate source, or the like. Such a system is particularly useful in a deregulated energy market, where consumers are free to choose from multiple sources of energy.

In contrast to the systems and methods recited by the present claims, the primary reference, Kincheloa, describes a "calculator-like" device that monitors energy consumption within a home. *See, e.g.*, Kincheloa Figure 1 and col. 3, lines 5-11. Users manually enter pricing information on a keypad on the device (col. 2, lines 8-11). The device is hard-wired (Figure 1, element 22) to a network of analog sensors that are present within the home's electrical wiring (*see, e.g.*, col 7, line 54 through col. 8, line 34). Accordingly, the Kincheloa device is not a remote monitoring device at all, but rather monitors electricity consumption at the site where the device is located. The Kincheloa reference contains absolutely no reference whatsoever to a central data processing system that communicates with a remote meter via a communications medium, nor does it contemplate providing pricing information to the consumer via a communications medium. Moreover, the Kincheloa calculator-like device is complete unto itself, and could not be modified to incorporate a data processing system communicating with a remote meter via a communications medium, as recited by the present claims. Such a modification would not be possible because such functionality would

have been far beyond the scope of the disclosure, and because a modification would defeat Kincheloa's purpose of providing a convenient on-site monitoring device for a single home. Accordingly, Kincheloa does not expressly or impliedly disclose each and every element of the present claims.

The Saar reference similarly fails to expressly or impliedly disclose the missing elements of the present claims. Saar describes a system for tracking water usage of individual units within a multi-unit housing building. The Saar device includes a number of volumetric flow sensors equipped with wireless transmitters so that water flow information can be compiled for each unit in a multi-tenant housing facility at a receiver. Importantly, the bulk of the Saar disclosure is concerned with describing the sensor device; only a brief portion of the Saar disclosure is dedicated to describing the functionality of the receiving unit. The only descriptions of a billing system in the Saar reference can be found the last clause of the Abstract and in a single sentence at column 5, lines 39-47, where it is stated without elaboration that "bills for water, energy and sewer use for each reporting unit...can be sent directly to the individual units". While this statement is the only reference to providing feedback from the system to the consumer, the reference does not suggest or describe the manner in which such information is "sent", nor does it provide any elaboration other than that a bill can be sent along with reporting of leaks or open faucets. In particular, no mention is made of providing information to the consumer "such that said utility consumer is allowed to thereby manage said utility cost for said remote facility", as recited by the amended claims. To the contrary, the limited information provided by the Saar system is limited to a monthly billing statement -- there is no suggestion that data could be provided in a format that would allow the user to manage energy costs by shifting production times.

seeking alternate sources of energy, or the like. These options would have no purpose in the Saar system, which is concerned merely with assigning utility costs to the various units in a multi-unit housing facility. Further, the Saar reference fails to disclose the provision of real-time data as recited in dependent claims 24 and 31.

It is well-settled that a combination of references cannot be cited unless some teaching, suggestion or motivation to combine the references exist. Graham v. John Deere Co., 383 U.S. 1, 17-18, 148 USPQ 459, 467 (1966). The suggestion may come from the references themselves, or from general knowledge in the relevant area of technology. In the present case, however, there is no suggestion whatsoever to combine the Kinchela and Saar references to arrive at the present invention. Each reference is complete unto itself, and contains no express suggestion to modify the teachings therein to arrive at (or even approach) the present invention. The two references address separate technological problems (i.e. providing a local monitoring device, and apportioning water costs between tenants in multi-unit housing). Neither reference would solve the problem provided by the present system, which allows users to manage utility costs by altering production schedules, obtaining energy from alternate sources, or the like. Accordingly, it is highly unlikely that even a person skilled in the art would seek to combine the two references without using the teaching of the present disclosure. Indeed, the lack of closer art in the relatively crowded field of utility services argues strongly in favor of non-obviousness, and therefore patentability.

In the section entitled "Response to Arguments", the Final Office Action essentially states that the prior rejections did not make improper use of hindsight reasoning, citing a Court of Customs and Patent Appeals case dating back to 1971. The Final Office Action

does not address the other arguments brought out in Applicant's earlier response, including the lack of suggestion to combine the Kincheloa and Saar references.

The Federal Circuit Court of Appeals very recently reiterated that "[t]he factual inquiry whether to combine references must be thorough and searching", that "[the inquiry] must be based on objective evidence of record", and that "[t]his precedent has been reinforced in myriad decisions, and cannot be dispensed with." *In Re Sang Su Lee*, \_\_\_\_\_ F.3d \_\_\_\_\_, (case 00-1158) (Fed.Cir.2002). In handing down the Sang Su Lee opinion, the Federal Circuit was very clear that it is the Office's burden to set forth with specificity the reasons for combining the cited references to arrive at a conclusion of obviousness. In the present application, the Final Office Action states without elaboration that "it would be obvious to a person of ordinary skill to combine the teaching in Kincheloe and Saar in order to obtain a more economical method of measuring and billing for electricity". This rationale is insufficient to support a claim of obviousness under the standard articulated by the Federal Circuit since it fails to disclose the line of reasoning followed by the Office, and in fact unfairly "uses that which the inventor taught against its teacher". *Id.*, citing W.L. Gore v. Garlock, Inc., 721 F.2d 1540, 1553, 220 USPQ 303, 312-13 (Fed. Cir. 1983).

Even assuming *arguendo* that one skilled in the art were motivated to combine the two references, however, this combination would still not disclose each and every element of the present claims. Even if the Kincheloa calculator-like device were incorporated in to the Saar multi-unit water monitoring system, the combination would not include a data processing system in communication with a remotely-located meter via a communications medium (such as the Internet) to receive metering data and to provide utility cost information based upon pricing factors to a utility consumer such that the consumer is able to manage

utility consumption at the consumer's facility, or of the other systems and methods recited in the present claims. The dependent claims offer additional features that are distinct from the cited combination.

The Final Office Action also cites the Crooks reference in combination with Kincheloa and Saar against prior claims 9 and 11-16. Applicant has cancelled the subject claims, so the rejection is believed to be moot. Nevertheless, Applicant respectfully points out that the Crooks reference is limited to disclosing a bill payment system, and is in no way concerned with gathering metering information. Accordingly, the elements of Applicant's claims that are not present in the Kincheloa/Saar combination are similarly not provided in the Kincheloa/Saar/Crooks combination. Further, no motivation exists to combine the Crooks disclosure with either or both of the other references, as set forth above. Applicant reserves the right to point out the novelty in features of particular dependent claims should it become relevant at a later date. Nevertheless, it is sufficient at this time to reiterate the arguments above in view of the present claims.

**Conclusion**

In sum, Applicant respectfully submits that the present application is in condition for allowance, and earnestly solicits a Notice of Allowance at the Examiner's earliest convenience. **The Examiner is earnestly invited to telephone the undersigned if such would advance prosecution of this Application in any way.**

Dated this 22<sup>nd</sup> day of April, 2002.

Respectfully submitted on behalf of  
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